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1 in question. Further, Horiki does not teach anything remotely similar to that described  
by applicants in the specification and the claims. In applicants' invention, the  
polyurethane adhesive is the masking agent while in Horiki, the masking element is  
secured to the metal by an adhesive agent. In other words, Horiki's adhesive material  
5 is not the masking element but only secures the masking element to the metal  
material.

In determining the differences between the prior art and the claims, the question  
under 35 U.S.C. § 103 is not whether the differences themselves would have been  
10 obvious, but whether the claimed invention as a whole would have been obvious.  
Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A  
prior art reference must be considered in its entirety, *i.e.*, as a whole, including  
portions that would lead away from the claimed invention. W.L. Gore & Associates,  
Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Distilling an  
15 invention down to the "gist" or "thrust" of an invention disregards the requirement of  
analyzing the subject matter "as a whole". Id. Impermissible hindsight must be  
avoided and the legal conclusion must be reached on the basis of the facts claimed  
from the prior art. MPEP § 2142.

20 The prior art must suggest the desirability of the claimed invention. There are  
three possible sources for a motivation to combine or modify a reference: the nature of  
the problem to be solved, the teachings of the prior art, and the knowledge of persons  
of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,  
1457-58 (Fed. Cir. 1998) (stating that the combination of references taught every  
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1 element of the claimed invention, however without a motivation to combine, a rejection  
based on a *prima facie* case of obviousness was held improper). Furthermore, the  
fact that references can be combined or modified is not sufficient to establish *prima*  
*facie* obviousness. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).  
5 (Emphasis provided). Although a prior art device "may be capable of being modified to  
run the way the apparatus is claimed, there must be some suggestion or motivation in  
the reference to do so." Id. Also, a statement that "modifications of the prior art meet  
the claimed invention would have been 'well within the ordinary skill of the art at the  
10 time the invention was made because the references relied upon teach that all aspects  
of the claimed invention were individually known in the art' is not sufficient to establish  
a *prima facie* case of obviousness without some objective reason to combine or modify  
the teachings of the references." Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat.  
App. & Inter. 1993); see also, In re Kotzob, 217 F.3d 1365, 1371, 55 USPQ2d 1313,  
15 1318 (Fed. Cir. 2000) (the court reversed an obviousness rejection involving a  
technologically simple concept because there was no finding as to the principle or  
specific understanding within the knowledge of a skilled artisan that would have  
motivated the skilled artisan to make the claimed invention).

20 Applicants assert that there is no suggestion or motivation whatsoever to modify  
the prior art as the Examiner has proposed. The Examiner merely makes a blanket  
rejection that the limitations of the claims would have been obvious. Again, as set  
forth above, the Examiner is not allowed to make such a rejection.

1 Moreover, to establish *prima facie* obviousness of a claimed invention, all of the  
claimed limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d  
981, 180 USPQ 580 (CCPA 1974). All words in the claim must be considered in  
judging the patentability of the claim against the prior art. In re Wilson, 424 F.2d 1382,  
5 1385, 165 USPQ 494, 496 (CCPA 1970).

The Examiner's cited prior art does not teach or otherwise suggest the  
limitations of the claims in this application. Accordingly, applicants assert that the  
claims in this application are allowable over the Examiner's 35 U.S.C. § 103(a)  
10 rejection.

No fees or extensions of time are believed to be due in connection with this  
Amendment; however, please consider this a request for any extension inadvertently  
omitted and charge any additional fees to Deposit Account No. 502093.

15 Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that the original of this AMENDMENT for LONNIE E. JARVIS, ET AL., Serial No. 10/776,107, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, Alexandria, VA 22313, on this 24<sup>th</sup> day of February, 2005.

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